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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re WebDialogs, Inc.

Serial No. 75/638,401

Michael J. Bevilacqua and Barbara A. Barakat of Hale and
Dorr LLP for WebDialogs, Inc.

Irene D. Williams, Trademark Examining Attorney, Law Office
112 (Janice O'Lear, Managing Attorney).

Before Seeherman, Hairston and Bottorff, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

WebDialogs, Inc. has appealed from the final refusal
of the Trademark Examining Attorney to register
"WebDialogs" and design, as shown below, as a trademark for
"computer programs for use in establishing live interaction

sessions over local, national and global information networks; computer hardware, namely computer server."¹



The Examining Attorney has made final a requirement for applicant to disclaim exclusive rights to "WebDialogs" apart from the mark as shown.

Applicant and the Examining Attorney have filed appeal briefs. Applicant did not file a reply brief, nor did it request an oral hearing.

Section 6 of the Trademark Act, 15 U.S.C. 1056(a), provides that "the Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable." Section 2(e)(1) of the Act, 15 U.S.C. 1052(e)(1) prohibits, inter alia, registration of a term which, when used on or in connection with the goods of the applicant, is merely descriptive of them.

¹ Application Serial No. 75/638,401, filed February 11, 1999, and asserting a bona fide intention to use the mark in commerce.

It is the Examining Attorney's position that "WebDialogs" is merely descriptive of applicant's goods because it describes the function of the software, and therefore it must be disclaimed. In support of this position the Examining Attorney has made of record several excerpts taken from the LEXIS/NEXIS database, including the following:

...few have multiple web pages and none comes close to the intensity of Rockland's web dialogue.

"The Patriot Ledger" (Quincy, MA),
"January 31, 2002

He co-edits bitterlemons.org, an Israeli-Palestinian Web-based dialogue.
"Los Angeles Times," April 21, 2002

Thus many programs that ate [sic-are] made to read unstructured text such as email or Web chat dialogs depend on finding structured text they do understand.

"Customer Interaction Solutions,"
April 1, 2002

Headline: Web dialogue is short and sloppy; McGreevey and pupils share cyber connection
"The Philadelphia Inquirer,"
January 16, 2002

...cross-departmental support teams, outside vendors and partners—can securely view and participate in a unique shared Web-based dialog.
"Business Wire," March 25, 2002²

² Although a wire service report is not evidence that the article has been circulated among the public, it does show the author's understanding of a particular term.

The Examining Attorney has also submitted, with her appeal brief, dictionary definitions of "web," "dialogue," "World Wide Web" and "interactive":³

web: *capitalized* WORLD WIDE WEB⁴

dialog: a. a conversation between two or more persons; also: a similar exchange between a person and something else (as a computer)
b: an exchange of ideas and opinions
c: a discussion between representatives of parties to a conflict that is aimed at resolution⁵

interactive: 1. Acting or capable of acting on each other.
2. *Computer Science* of or relating to a two-way electronic or communications system in which response is direct and continual⁶

World Wide Web: *Computer Science*. An information server on the Internet composed of interconnected sites and files, accessible with a browser.⁷

³ The Examining Attorney stated in her appeal brief that the dictionary definitions were of record. In point of fact, the definitions were not made of record prior to the filing of the appeal, and therefore were never properly made of record. See Trademark Rule 2.142(d). However, the Board may take judicial notice of dictionary definitions, **University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.**, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), and we do so in this case.

⁴ Merriam-Webster On Line Dictionary

⁵ Merriam-Webster On Line Dictionary

⁶ The American Heritage Dictionary of the English Language, 3d ed. © 1992.

⁷ The American Heritage Dictionary of the English Language, 3d ed. © 1992.

A term is merely descriptive, and therefore unregistrable pursuant to Section 2(e)(1) of the Act, if it immediately conveys knowledge of an ingredient, quality, function, feature, composition, purpose, attribute, use, etc. of the goods or services in connection with which it is used or intended to be used. See **In re Engineering Systems Corp.**, 2 USPQ2d 1075 (TTAB 1986). See also, **In re Gyulay**, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

Descriptiveness of a mark is not considered in the abstract, but in relation to the particular goods or services for which registration is sought. **In re Abcor Dev. Corp.**, 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

After reviewing the evidence of record, we have no doubt that applicant's mark immediately describes the purpose of its computer programs. Applicant's very identification of goods—computer programs for use in establishing live interaction sessions over local, national and global information networks—shows that the software allows people to have dialogs (live interaction sessions) on the web (global information network). The NEXIS excerpts show that phrases such as "web dialogue," "Web-based dialogue" and "Web chat dialogs" are used to refer to the exchange of information that applicant's identified computer programs are used to establish.

It would require no imagination or thought on the part of consumers viewing the term "WebDialogs" as part of a trademark for "computer programs for use in establishing live interaction sessions over local, national and global information networks" to understand that the computer programs enable dialogs on the web to occur. Applicant itself acknowledges that its programs set up a place in the information network where an interaction session can take place. Thus, "WebDialogs" is merely descriptive of a purpose of the computer programs, i.e., to set up a place for web dialogs, or dialogs on the web.

Applicant points out that the NEXIS articles submitted by the Examining Attorney are all dated on or after January 1, 2002, which is almost three years after applicant's application was filed. It is noted that the search undertaken by the Examining Attorney retrieved 275 stories, and the nine which the Examining Attorney made of record were presumably the first ones that were retrieved, since NEXIS articles are displayed in reverse chronological order. More importantly, even if we were to assume that all references to "web dialogs" were made in articles published after applicant's filing date, the uses shown in the articles are descriptive uses, not third-party trademark uses. Thus, we cannot view these uses as

infringing. Rather, they show that, even if applicant intended, when it filed its application, to claim "web dialogs" as part of its trademark, the authors of the articles, and the public to whom the term has been exposed, regard it as descriptive. Applicant's comment that it alone uses the term "WebDialogs" as its trademark does not in any way mandate a finding that this term is not merely descriptive; on the contrary, one would not expect to find third parties using a merely descriptive term as a trademark.

Applicant also points out that six of the articles submitted by the Examining Attorney do not use the specific term "webdialogs." The fact that applicant runs the words "web" and "dialogs" together to form "WebDialogs" does not avoid the descriptiveness of this term, especially since the special form in which "WebDialogs" is depicted in applicant's mark, with a capital "W" and a capital "D," reinforces the commercial impression that it is the two words. Nor does the fact that applicant uses the spelling "dialogs," and several of the articles use "dialogues" or "dialogue," avoid a finding of mere descriptiveness. Clearly "dialogue" and "dialogue" are alternate spellings. See The American Heritage Dictionary of the English Language ©1970. Finally, although the articles submitted

by the Examining Attorney do not refer to computer programs, or use "web dialog/web dialogues" to describe the programs, the articles show that consumers regard this term as indicating live interaction sessions over global information networks. Because establishing these sessions is what applicant's computer programs do, "WebDialogs" describes the purpose of the programs.

Decision: The requirement for a disclaimer of "WebDialogs" is affirmed, and therefore the refusal of registration in the absence of such disclaimer is affirmed. Applicant is allowed thirty days from the mailing date of this decision to submit the required disclaimer, in which case this decision will be set aside, and the application will proceed to publication. See Trademark Rule 2.142(g).